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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/509,921

06/26/2000

Richard Ameling

GEY-1069/500350.20076

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7590

02/03/2009

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

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NEW YORK, NY 10022-7650

EXAMINER

NAGPAUL, JYOTI

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

02/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/509,921	<b>Applicant(s)</b> AMELING ET AL.	
	<b>Examiner</b> JYOTI NAGPAUL	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

Rejection of Claims 5 and 8-10 as being anticipated by Hutchins (US 5928952) has been modified in light applicants' amendments.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 5 and 8-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Hutchins (US 5928952).

Hutchins teaches a processing system comprising modules (12) with devices for at least one or more of the following: preparing specimens, introducing specimens, optical readout, plate storage and devices for further processing steps or readout steps. Hutchins teaches within each module (12) is at least one revolving table (18), the carousel racks shown in Figure 2, having two plate positions. The two plate positions disclosed in Hutchins is a position located in the revolving table for each plate (42). Hutchins further teaches at least one central transport system (21). Applicants' further recite the at least one central transport system "for asynchronous plate transfer between individuals modules." This is a method limitation which is of no patentable significance in apparatus claims. Additionally, applicant does not claim as to what structural element is attributing to asynchronous plate transfer. In applicants' disclosure on page 4 Lines

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22-25, applicants' merely disclose "transport between the modules is carried out asynchronously with a separate transport system between the output buffer and input buffer of successive modules. The sequence of plate transport is freely definable. The control of a module is carried out via a local control unit." This appears to be a method limitation. The at least one central transport system of Hutchins is capable of performing asynchronous plate transfer between individuals modules. Hutchins further teaches one of the revolving tables (18) of each module (12) *functions as* an input and output buffer to transfer the plates to and from the at least one central transport system (21). Again, apparatus claims as claimed by applicants' must be structurally distinguishable from the prior art and not functionally. Hutchins revolving table (18) of each module is capable of functioning as an input and output buffer to transfer the plates to and from the at least one central transport system (21). Hutchins further teaches an internal transport system (62) for transporting the microtiter plates between the different devices. The internal transport system (62) transports the microtiter plates by means of the revolving tables (18) and sliding units (58). The at least one of the modules (18) is connected with a local computer (80) with externally standardized interface and the transport and/or processing and/or optical readout are/is controlled by a master computer via these interfaces. Hutchins further teaches sensor/signals that detect whether or not the respective side of the revolving table is unoccupied to ensure that no collisions occur. Hutchins further teaches means for providing a clocked operation so that a revolving table is always inserting one microtiter plate and guiding out another microtiter plate. (See Col. 6, Lines 1-55)

***Response to Arguments***

3. Applicant's arguments filed on November 19, 2008 have been fully considered but they are not persuasive. Applicants argue that Hutchins does not anticipate at least one revolving table having two plate positions is within each module. Refer to the rejection above. Applicants further argue that Hutchins does not disclose asynchronous plate transfer between individual modules. This appears to be a method limitation and is of no patentable significance in apparatus claims. Additionally, applicants do not claim any structural elements as to what makes the central transport system is asynchronous.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JN

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797